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(A)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/685,338 07/23/96 WANG

L S63.2-5902

EXAMINER

000490 QM32/0316
VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA MN 55343-9185

RODRIGUEZ, C

ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 27

Application Number: 08/685,338

Filing Date: July 23, 1996

Appellant(s): Wang et al.

William E. Anderson II
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to Remand to Examiner on appeal filed September 27, 2000.

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(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claim 11 stands or falls alone because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

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The rejection of claims 12-14 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claim 15 stand or falls alone because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 16-17 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claim 35 stand or falls alone because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claim 36 stand or falls alone because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claim 37 stand or falls alone because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

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The rejection of claims 38-39 and 45 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 40-42 and 44 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 43 stand or falls alone because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 46-47 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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5,344,400	KANEKO ET AL	9-1994
5,167,239	COHEN ET AL	12-1992

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al(5,500,180).

Anderson et al. discloses a thermoplastic polymer material balloon and a method of making the balloon, where the thermoplastic polymer material is a block copolymer material(ie, polyurethane block copolymer, col. 8 line 26). Anderson et al. teaches the balloon as claimed, which has been made by a process similar to that of Appellants. Specifically, Anderson et al teaches heating and pressurizing a block copolymer at first elevated temperature and pressures followed by annealing at second temperatures and pressures lower than the first (see examples 2 and 3). Since the reactants reaction conditions, and properties of the Anderson process are

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similar to that of the instant, it is held that the resultant product of Anderson et al anticipates the instant product by process of claim 11.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12-17, 35-42, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al(5,500,180).

With respect to claims 12-17 and 35-39, Anderson et al teaches the balloon as claimed having the following parameters such as: 1)operational pressures which the balloon can be safely inflated without bursting of at least 12 atm (see Examples 3 and 4), 2)a nominal diameter of 3 mm at a certain inflation pressure, and 3)a diameter growth disclosed at column 4 lines 59-65 over a range of 3-12 atm. With respect to claims 40-45, Anderson et al teaches in column 3 line 32 - column 4 line 65, 4)an average compliance(distensibility) to burst the balloon, and in column 6 lines 5-23 discloses average compliance for the balloon of about 5 to 20%, and 5)burst pressures of at least 9 atm (see Examples 3 and 4). Further, Anderson et al teaches that all these balloon characteristics depend from the material construction and the wall thickness of the balloon which are controllable during the process of making the balloon. However, Anderson et al does not

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teach all the varying parameters of the of 1)operational pressure, 2)nominal diameter at an inflation pressure of 3 atm, 3)diameter growth, and 4)average compliance as claimed. Such parameters are deemed to have been an obvious design choice, obvious to and well-within the level of skill of the ordinary artisan achieved thru routine experimentation in determining similar optimal results for the claimed balloons.

5. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. in view of Kaneko et al(5,344,400).

Anderson et al. discloses the invention substantially as claimed. However, Anderson et al. does not disclose the balloon formed from at least two concentric layers of different thermoplastic polymers.

Kaneko et al. teaches a balloon having at least two concentric layers of different thermoplastic polymers for the purpose of stability and flexibility. One of the layers 17 may contain a block copolymer(col. 5 lines 3-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Anderson et al. by providing the at least two concentric layers of different thermoplastic polymers as shown by Kaneko et al. in order to improve the stability and flexibility of the balloon.

6. Claims 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. in view of Cohen et al(5, 167,239).

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Anderson et al. discloses the invention substantially as claimed. However, Anderson et al. does not disclose a method of treating a gastrointestinal lesion having the steps as claimed by Applicant.

Cohen et al. teaches an anchorable guidewire for treating a gastrointestinal lesion having the steps as claimed by Applicant(see col. 42-55 and throughout the specification). It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the guidewire of Cohen et al. with the Anderson's et al.'s catheter and treat a gastrointestinal lesion using the steps taught by Cohen et al. where substituting one device for the other would have been obvious depending on Applicant's intention.

(11) *Response to Argument*

In response to Appellant's arguments that the shrinking process used in the invention is quite different from the heat set technique used in the Anderson et al. reference, the Examiner direct Appellant's attention to the M.P.E.P 2113 and 2173.05(p), where clearly set forth that a "Product by Process Claims" are not limited to the manipulations of the recited steps, but only the structure implied by the steps. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the

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product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Because the claims are product by process claims, determination of patentability is based on the product itself.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

CRL 3/6/01
Cris L. Rodriguez
March 6, 2001

Sharon Kennedy
Sharon Kennedy
Primary Examiner

VIDAS ARRET & STEINKRAUS
Suite 2000
6109 Blue Circle Drive
Minnetonka, MN 55343-9131

RKS
RICHARD K. SEIDEL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700